

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

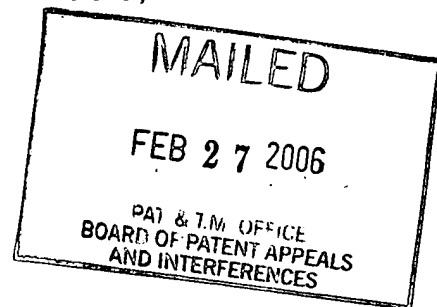
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRUCE EISEN, ROGER PADAYAO, WASEF KASSIS,
and JAMES E. LUCAS IV

Appeal No. 2005-1659
Application No. 09/379,167

HEARD: February 7, 2006



Before GROSS, BLANKENSHIP, and NAPPI, Administrative Patent Judges.

BLANKENSHIP, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-52 and 75-82, which are all the claims pending in the application.

We reverse, and enter a new ground of rejection in accordance with 37 CFR § 41.50(b).

BACKGROUND

The invention relates to electronic sending of promotional and advertising materials that include a unique identifier to a consumer's electronic mail address. The electronic mail to the consumer includes embedded Internet Web sites, and consumer activity within the Web sites is tracked based on the unique identifier. Further material may then be sent to the consumer based upon the consumer's movement within the embedded Web sites. Claims 45 and 52 are reproduced below.

45. A method for electronically identifying a consumer without requiring consumer registration, the method comprising:

receiving a consumer request to access one or more web sites implemented on at least one server computer, wherein the consumer request is submitted by way of a client computer and the request includes a web site address, sent to the consumer in an electronic mail message, with a unique identifier embedded in the web site address for uniquely identifying the particular consumer;

parsing the web site address to find the unique identifier; and

logging the unique identifier in one or more log files in association with information that defines consumer activity within said one or more web sites, independent from any consumer profile information previously stored on the client computer by any servers.

52. A unique identifier embedded in a URL provided to a consumer by way electronic mail, such that when the consumer selects the URL a connection is established between a consumer computer having a first IP address and a web server providing access to one or more web sites, wherein the web server receives the URL via said established connection independent from any consumer profile information previously stored on the client computer, wherein the web server parses the URL for the unique identifier, and wherein the IP address is recorded in a log file in association with the unique identifier.

The examiner relies on the following reference:

Capiel	US 6,449,634 B1	Sep. 10, 2002 (filed Jan. 29, 1999)
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Claims 1-52 and 75-82 stand rejected under 35 U.S.C. § 103 as being unpatentable over Capiel.

We refer to the Examiner's Answer (mailed Nov. 24, 2004) for a statement of the examiner's position and to the Brief (filed Jul. 21, 2004) and the Reply Brief (filed Feb. 25, 2005) for appellants' position with respect to the claims which stand rejected.

OPINION

Capiel

Capiel discloses an "E-mail sensor system" including an E-mail sensor server 130 (Fig. 1) that communicates with the E-mail sensor database 132. The E-mail sensor server 130 serves as a "middleman" information collection point between the vendor systems 112, 114, 116, and the E-mail clients 142, 144, 146, and 148. Col. 2, l. 65 - col. 3, l. 21.

A vendor may have its own World Wide Web home site, with the site's web pages containing HTML documents. The vendor may send its HTML document information, along with its client list, to the E-mail sensor server 130, which would store the information in the E-mail sensor database 132. The E-mail server 134 would access the database 132 and include the vendor's HTML information in the "E-mail

sensors" sent to all E-mail clients on the vendor's customer list. If an E-mail client can process and execute HTML statements, the client will send a response back to the E-mail sensor server 130. The response may be implemented by the E-mail client software executing a HTML "image tag" statement, which calls a program on the E-mail sensor server. The E-mail sensor server may then update its E-mail sensor database 132. In one embodiment, E-mail messages sent to a client that contain hyperlinks to the vendor are all channeled through E-mail sensor server 130. Further, if the client can process only text, then the E-mail client may display only the textual information included in the E-mail sensor. Future E-mail messages sent to the client may contain only textual information. Col. 3, ll. 22-57. The HTML image tag is appended by E-mail server 134. Col. 4, ll. 32-34.

A specific example of the E-mail sensor message sent to an E-mail client is set forth at column 5, line 39 et seq. The HTML image tag is described in detail at column 7, line 33 et seq. The E-mail address of each recipient is included as a parameter in the HTML statement, along with a code that is unique to every E-mail delivered. When multiple messages are sent to the same recipient, the unique E-mail code will change to identify different messages. Col. 7, ll. 47-57. A specific example of the E-mail sensor server program is set forth at column 11, line 4 et seq. When the HTML image tag is executed at an E-mail client, a request is made to a computer located at Internet address "sensorserver.domain.com" to run program "sensor server program" with parameters "E-mail address" and "unique mail code." In the example provided, the

address "sensorserver.domain.com" is for the E-mail sensor server 130. The sensor server program updates three relational database tables. A "catalogs" table is included, in which the unique E-mail code is stored, along with the date and time the E-mail client first opens the E-mail message, and the count of number of times the E-mail message is opened. Col. 12, l. 52 - col. 13, l. 9; Table 1.

The rejection

Appellants' Reply Brief appears intended to be a complete brief in accordance with 37 CFR § 41.37.¹ Appellants presume that the Answer sets forth a new ground of rejection. The presumption is reasonable, as the Answer indicates (e.g., at 31-32) that claims 75-82 are rejected under 35 U.S.C. § 103 as being unpatentable over Capiel in what is designated a new ground of rejection. However, Office policy for a new ground of rejection entered in an Examiner's Answer (37 CFR § 41.39) requires that the new ground be approved by a Technology Center Director or designee. (See, e.g., Manual of Patent Examining Procedure § 1207.03 (8th Ed., Rev. 3, Aug. 2005), under the heading, "I. REQUIREMENTS FOR A NEW GROUND OF REJECTION"). The signed, final page of the Answer does not indicate that a Director or designee signed the paper.

¹ For future reference, however, we note that we will not consider arguments that are purported to be "incorporated by reference" with respect to earlier papers that have been filed. See 37 CFR § 41.37(c)(1)(vii) ("Any arguments or authorities not included in the brief or a reply brief filed pursuant to § 41.41 will be refused consideration by the Board, unless good cause is shown.").

Further, multiple pages in the Answer appear to be reproduced from earlier Office actions. We therefore conclude that the Answer contains no new grounds of rejection.

The Reply Brief refers (e.g., at 3) to declarations submitted as objective evidence of nonobviousness, which are included in the Evidence Appendix.² Yet, the Reply Brief was noted as being entered and considered, without further comment by the examiner, in a paper mailed in March, 2005. Moreover, we do not find where the examiner may have addressed the evidence in the Answer.

After a prima facie case of obviousness has been established, the burden of going forward shifts to the applicant. In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). Rebuttal is merely a showing of facts supporting the opposite conclusion, and may relate to any of the Graham factors including the so-called secondary considerations. If rebuttal evidence of adequate weight is produced, the holding of prima facie obviousness, being but a legal inference from previously uncontradicted evidence, is dissipated. Id. Rebuttal evidence must be evaluated along with the facts on which the earlier conclusion was reached, not against the conclusion itself. Id. (citing In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

We do not have any substantive treatment by the examiner of the rebuttal evidence, and no explanation as to why the overall weight of the objective evidence of

² The declarations were apparently entered into the record during prosecution.

nonobviousness is deemed to not outweigh the evidence of obviousness relied upon by the examiner. The application could be remanded to the examiner for consideration of the evidence on the record. However, we conclude that the proffered rejection fails to establish a prima facie case of obviousness. We therefore reverse, rather than remand.

The rejection of independent claim 1 (Answer at 7-10) points to multiple columns and lines of Capiel as showing "elements that suggest" the language of all of claim 1. Although the reference lacks "an explicit recitation" of some of the claim language, the rejection asserts that the disclosure of Capiel "would have been selected in accordance with" the non-explicit claim language because selection of such features would have provided means "to identify the audience and tailor the advertising to that audience," referring to column 1, lines 22 through 24 of the reference.

The language of the rejection indicates an improper hindsight reconstruction of the claimed invention. The rejection of the other independent claims (e.g., claim 45 at pages 26-27 and claim 75 at page 32) takes the same form.

Instant claim 45 recites parsing the web site address to find the unique identifier, and logging the unique identifier in one or more log files (e.g., a log file) in association with information that defines consumer activity within one or more web sites (e.g, a web site). In Capiel's system, as we have noted, the HTML image tag is executed at the E-mail client, and a request is made to an E-mail sensor server to run a program with parameters that include the unique mail code. The sensor server program stores the

unique mail code in a table in association with information regarding the E-mail client's viewing of the E-mail message that the client received. Capiel col. 12, l. 52 - col. 13, l. 9; Table 1.

The rejection attempts to remedy the deficiencies in Capiel's teachings by reliance on the column 1, lines 22 through 24 disclosure of the challenge "to identify the audience and tailor the advertising to that audience." Read in context, however, the objective teaching relates to assuring that advertisements reach the consumer in a proper format, such that the user receives a format that can be properly displayed (e.g., graphics or text). While in hindsight one might appreciate that the unique identifiers described by Capiel could be used in the manner that is claimed, the reference standing alone does not support a prima facie case for obviousness of the subject matter as a whole of instant claim 45.³

Independent claims 1, 22, 75, 78, and 81 contain substantially the same limitations we have identified in claim 45. The rejection also fails to set forth a prima facie case of obviousness with respect to claim 52, the sole remaining independent claim. We therefore do not sustain the rejection of any of the claims on appeal. However, we enter a new ground of rejection against claim 52.

³ There appears to be an ambiguity in Capiel in that columns 7 and 12 describe calling a program on the E-mail sensor server, but the example of the E-mail sensor message that is provided seems to indicate calling the program on the vendor's Web site (i.e., "Vendor.m0.net"). See col. 6, ll. 57-59. In any event, a disclosure of sending the unique ID as a parameter to a program on the vendor's site falls short of disclosing or suggesting the noted requirements of claim 45.

New ground of rejection

We enter the following new ground of rejection against the claims in accordance with 37 CFR § 41.50(b): Claim 52 is rejected under 35 U.S.C. § 102(e)(2) as being anticipated by Capiel.

Instant claim 52 requires a unique identifier embedded in a URL. Capiel discloses a unique identifier embedded in a URL (e.g., col. 7, ll. 34-39, in reference to the HTML image tag).

The functional language (e.g., “such that”) and process steps (e.g., wherein “the web server receives the URL”) in claim 52 that relate to the unique identifier embedded in a URL do not change the entity⁴ that is claimed. We interpret the language of claim 52 describing how the unique identifier embedded in a URL may be used as merely recitations of intended use, rather than requiring the operations that are named. A claim that recites both a unique identifier embedded in a URL and a method of using the same would not pass muster under 35 U.S.C. § 112, second paragraph. See IPXL Holdings LLC v. Amazon.com Inc., 430 F.3d 1377, 1384, 77 USPQ2d 1140, 1145 (Fed. Cir. 2005) (a claim that recites both a system and the method for using that system does not apprise a person of ordinary skill in the art of its scope, and is thus invalid under § 112, second paragraph).

⁴ Although it is not clear that claim 52 is drawn to statutory subject matter, for present purposes we will presume that a “manufacture” within the meaning of 35 U.S.C. § 101 is claimed.

We note that evidence submitted to show nonobviousness is not relevant or material when an invention is anticipated. Evidence of secondary considerations such as "long-felt but unresolved need" is irrelevant when the invention lacks novelty. See, e.g., In re Malagari, 499 F.2d 1297, 1302, 182 USPQ 549, 553 (CCPA 1974) (citing In re Wiggins, 488 F.2d 538, 179 USPQ 421 (CCPA 1973)).

CONCLUSION

The rejection of claims 1-52 and 75-82 under 35 U.S.C. § 103 as being unpatentable over Capiel is reversed.

A new rejection of claim 52 under 35 U.S.C. § 102 as being anticipated by Capiel is set forth herein.

This decision contains a new ground of rejection pursuant to 37 CFR § 41.50(b) (2005). 37 CFR § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 CFR § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

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(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a). See 37 CFR § 1.136(a)(1)(iv).

REVERSED -- 37 CFR § 41.50(b)

Anta Pellman Gross

ANITA PELLMAN GROSS
Administrative Patent Judge

Howard B. Blankenship

HOWARD B. BLANKENSHIP,
Administrative Patent Judge



~~ROBERT E. NAPPI~~
Administrative Patent Judge

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